

REMARKS

Claims 1-11, 13, 15, 16, and 22-33 are pending in the present Application. No claims have been canceled, Claims 23, 28, and 30 have been amended, and no claims have been added by this Amendment and Response, leaving Claims 1-11, 13, 15, 16, and 22-33 for consideration upon entry of the present Amendment.

The status identifier for Claim 26 has been changed to read “previously presented”. Claim 26 was amended in the response filed on January 22, 2008 to correctly depend from Claim 24, rather than Claim 23 as originally filed. Applicants apologize for the oversight.

Allowed Claims

Applicants note and wish to sincerely thank the Examiner for the allowance of Claims 1-11, 13, 15, 16, 22, 24-27 and 33, and the indication of allowable subject matter in Claims 29 and 32 which are objected to as depending from a rejected base claim but would be allowable if rewritten in independent form. Applicants believe that in light of the above amendments and remarks below, the Examiner will also find the remaining claims 23, 28, 30, and 31 to be allowable. Reconsideration of these claims is respectfully requested.

Amendments to Claims

Claim 23 has been amended to correctly depend from Claim 1. Claims 28 and 30 have each been amended to remove limitations to polyester as a binder. No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 23 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, Claim 23 depends from Claim 21, which has been canceled. The limitations of Claim 21 were previously included in Claim 1, and therefore Claim 23 has been amended to correctly depend from Claim 1. Claim 23 should accordingly now be acceptable to the Examiner. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 28, 30, and 31 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over United States Patent No. 6,359,232 to Markovitz, et al. (Markovitz). Applicants respectfully traverse this rejection.

Markovitz discloses a groundwall insulation formed of a mica tape filled with submicron particles of silicon dioxide, aluminum oxide, titanium dioxide, or zirconium dioxide, where the tape includes a resin binder. Col. 2, lines 45-67. The mica tape is essentially free of oxide particles. Col. 2, lines 61-67. Epoxy, polyester, and bismaleimide resins are disclosed. Col. 4, line 64 to Col. 5, line 3; Col. 5, lines 48-54.

“A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

Claims 28 and 30, as amended, do not disclose use of the resin binders disclosed in Markovitz, of epoxy, polyester, and bismaleimides, and there is no suggestion or incentive in Markovitz that would lead one skilled in the art to include the resins claimed in the instant claims. Markovitz discloses in the example 1 a baseline resin composition of an epoxy resin blend, comprising bisphenol A novolac accelerator and teaches this combination as a preferred combination, but fails to disclose a resin composition that does not include epoxy, polyester, or bismaleimide. Markovitz does not teach or disclose inclusion of other resin binders, and hence Markovitz does not teach all elements of the instant claims, and does not provide a *prima facie* case of obviousness.

Further, as all combinations disclosed in Markovitz include one of the three disclosed resins, with epoxy preferred, there is no suggestion or incentive that would lead one skilled in the art to so modify Markovitz to include the resins claimed in Claims 28 and 30, with a reasonable expectation for success. Markovitz discloses that the mica paper tapes have “a novel composition in accordance with the teachings of the invention”. Col. 1, lines 55-59. Markovitz further teaches that “the combination of tape materials appears to have a synergistic effect” and improved results over the individual components. Col. 1, lines 4-7. Markovitz does not appear to extend to any other resins in combination with the claimed

submicron filler combination. For this reason at least, Markovitz fails to teach all elements of Claims 28 and 30, and fails to provide a suggestion or incentive that would lead one skilled in the art to modify Markovitz to provide the filler and resin combinations claimed in Claims 28 and 30. Reconsideration and allowance are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0868.

Respectfully submitted,

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